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10/694,868	10/29/2003	Yohichiroh Matsuno	244714US2	5692
22850	7590	12/24/2008	EXAMINER	
OBLON, SPIVAK, MCCLELLAND MAIER & NEUSTADT, P.C. 1940 DUKE STREET ALEXANDRIA, VA 22314			COPPOLA, JACOB C	
			ART UNIT	PAPER NUMBER
			3621	
			NOTIFICATION DATE	DELIVERY MODE
			12/24/2008	ELECTRONIC

**Please find below and/or attached an Office communication concerning this application or proceeding.**

The time period for reply, if any, is set in the attached communication.

Notice of the Office communication was sent electronically on above-indicated "Notification Date" to the following e-mail address(es):

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**Office Action Summary**

Application No. 10/694,868	Applicant(s) MATSUNO ET AL.	
Examiner JACOB C. COPPOLA	Art Unit 3621	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

**Period for Reply**

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE 3 MONTH(S) OR THIRTY (30) DAYS, WHICHEVER IS LONGER, FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133). Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

**Status**

- 1)  Responsive to communication(s) filed on 06 November 2008.
- 2a)  This action is **FINAL**.                      2b)  This action is non-final.
- 3)  Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

**Disposition of Claims**

- 4)  Claim(s) 1-44 is/are pending in the application.  
4a) Of the above claim(s) 22-44 is/are withdrawn from consideration.
- 5)  Claim(s) \_\_\_\_\_ is/are allowed.
- 6)  Claim(s) 1-21 is/are rejected.
- 7)  Claim(s) \_\_\_\_\_ is/are objected to.
- 8)  Claim(s) \_\_\_\_\_ are subject to restriction and/or election requirement.

**Application Papers**

- 9)  The specification is objected to by the Examiner.
- 10)  The drawing(s) filed on \_\_\_\_\_ is/are: a)  accepted or b)  objected to by the Examiner.  
Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).  
Replacement drawing sheet(s) including the correction is required if the drawing(s) is objected to. See 37 CFR 1.121(d).
- 11)  The oath or declaration is objected to by the Examiner. Note the attached Office Action or form PTO-152.

**Priority under 35 U.S.C. § 119**

- 12)  Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).  
a)  All    b)  Some \*    c)  None of:
- 1.  Certified copies of the priority documents have been received.
  - 2.  Certified copies of the priority documents have been received in Application No. \_\_\_\_\_.
  - 3.  Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

\* See the attached detailed Office action for a list of the certified copies not received.

**Attachment(s)**

- |   |   |
|---|---|
| 1) <input checked="" type="checkbox"/> Notice of References Cited (PTO-892)   | 4) <input type="checkbox"/> Interview Summary (PTO-413)<br>Paper No(s)/Mail Date. _____ |
| 2) <input type="checkbox"/> Notice of Draftsperson's Patent Drawing Review (PTO-948)  | 5) <input type="checkbox"/> Notice of Informal Patent Application                       |
| 3) <input checked="" type="checkbox"/> Information Disclosure Statement(s) (PTO/SB/08)<br>Paper No(s)/Mail Date <u>17 July 2008</u> . | 6) <input type="checkbox"/> Other: _____  |

## **DETAILED ACTION**

### *Acknowledgements*

1. This action is in reply to the Restriction Election filed on 06 November 2008.
2. Claims 1-44 are currently pending and have been examined.
3. All references to the capitalized versions of “Applicants” refer specifically to the Applicants of record. Any references to lower case versions of “applicant” or “applicants” refer to any or all patent “applicants.” Unless expressly noted otherwise, references to “Examiner” refers to the Examiner of record while reference to or use of the lower case version of “examiner” or “examiners” refers to examiner(s) generally. The notations in this paragraph apply to this Office Action and any future office action(s) as well.
4. This Office Action is given Paper No. 20081215. This Paper No. is for reference purposes only.

### *Restrictions*

5. Applicants’ election without traverse of claims 1-21 in the reply filed on 06 November 2008 is acknowledged.
6. Claims 22-44 are withdrawn from further consideration pursuant to 37 CFR 1.142(b) as being drawn to a nonelected invention, there being no allowable generic or linking claim.

### *Information Disclosure Statement*

7. The Information Disclosure Statement filed on 17 July 2008 has been considered. An initialed copy of the Form 1449 is enclosed herewith.

***Claim Rejections - 35 USC § 101***

8. 35 U.S.C. 101 reads as follows:

Whoever invents or discovers any new and useful process, machine, manufacture, or composition of matter, or any new and useful improvement thereof, may obtain a patent therefor, subject to the conditions and requirements of this title.

9. Claims 1-21 are rejected under 35 U.S.C. 101 because the claimed invention is directed to non-statutory subject matter.

10. Regarding claims 1-10:

a. These claims recite “[a] service providing apparatus... comprising: an authentication request accepting section... an extension request accepting section... and an authentication information updating section”. In their broadest reasonable interpretation and in light of the specification, the three components recited above can be interpreted as software *per se*. Under the current guidelines of 35 U.S.C. §101, software *per se* is not patentable subject matter.

11. Regarding claims 11-20:

b. Based on Supreme Court precedent<sup>1</sup> and recent Federal Circuit decisions, a §101 process must (1) be tied to another statutory class (such as a particular apparatus) or (2) transform underlying subject matter (such as an article or materials) to a different state or thing. See *In re Bilski*, 88 USPQ2d 1385 (Fed. Cir. 2008) (en banc).

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<sup>1</sup> See also *Diamond v. Diehr*, 450 U.S. 175, 184 (1981); *Parker v. Flook*, 437 U.S. 584, 588 n.9 (1978); *Gottschalk v. Benson*, 409 U.S. 63, 70 (1972); *Cochrane v. Deener*, 94 U.S. 780, 787-88 (1876).

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c. An example of a method claim that would not qualify as a statutory process would be a claim that recited purely mental steps.

d. To meet prong (1), the method step should positively recite the other statutory class (the thing or product) to which it is tied. This may be accomplished by having the claim positively recite the machine that accomplishes the method steps. Alternatively or to meet prong (2), the method step should positively recite identifying the material that is being changed to a different state or positively recite the subject matter that is being transformed.

e. In this particular case, the claims fail prong (1) because the method steps are not tied to a machine and can be performed without the use of a particular machine.

Additionally, the claims fail prong (2) because the method steps do not transform the underlying subject matter to a different state or thing.

12. Regarding claim 21:

f. As recited, claim 21 is directed toward “[a] computer –readable storage medium which stores a program”. However, under the current guidelines of 35 U.S.C. §101, programs must be tangibly embodied on a computer readable medium, and, when executed by a computer processor, perform the steps of the code. In their broadest reasonable interpretation and in light of the specification, claim 21, as recited, can be interpreted to be embodied on abstract mediums (i.e. not tangibly embodied) such as carrier waves and signals, and therefore not eligible for patent protection.

***Claim Rejections - 35 USC § 112, 2<sup>nd</sup> Paragraph***

13. The following is a quotation of the second paragraph of 35 U.S.C. 112:

The specification shall conclude with one or more claims particularly pointing out and distinctly claiming the subject matter which the applicant regards as his invention.

14. Claims 1-10, 12, 13, 16, and 17 are rejected under 35 U.S.C. 112, second paragraph, as being indefinite for failing to particularly point out and distinctly claim the subject matter which Applicants regard as the invention.

15. Regarding claims 1-10:

g. These claims recite “the ticket”. These claims are indefinite because “the ticket” lacks antecedent basis in the claim.

16. Regarding claims 3, 6, 7, 10, 12, 13, 16, and 17:

h. These claims recite “in a related manner” and are indefinite because one of ordinary skill in the art would not understand the scope of the claimed subject matter when considering the use of “in a related manner”.

17. The Examiner finds that because the claims are indefinite under 35 U.S.C. §112, 2<sup>nd</sup> paragraph, it is impossible to properly construe claim scope at this time. However, in accordance with MPEP §2173.06 and the USPTO’s policy of trying to advance prosecution by providing art rejections even though these claims are indefinite, the claims are construed and the prior art is applied as much as practically possible.

***Claim Rejections - 35 USC § 103***

18. The following is a quotation of 35 U.S.C. §103(a) which forms the basis for all obviousness rejections set forth in this Office action:

(a) A patent may not be obtained though the invention is not identically disclosed or described as set forth in section 102 of this title, if the differences between the subject matter sought to be patented and the prior art are such that the subject matter as a whole would have been obvious at the time the invention was made to a person having ordinary skill in the art to which said subject matter pertains. Patentability shall not be negated by the manner in which the invention was made.

19. Claims 1-21, as understood by the Examiner, are rejected under 35 U.S.C. 103(a) as being unpatentable over Ooho et al. (U.S. 2003/0028454 A1) (“Ooho”), in view of Aldis et al. (U.S. 2004/0039916 A1) (“Aldis”).

20. Regarding claim 1:

i. Ooho discloses the following limitations:

i. *an authentication information managing section (license information management unit 48a) configured to manage authentication information related to the services (“license information” in the “license information table 421a”), the authentication information having a term of validity (¶ 0068; and fig. 4 with associated text);*

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ii. *an extension request accepting section (license information management unit 48a) configured to:*

(1) *accept an extension request to extend the term of validity of the authentication information (§ 0092),*

(2) *judge whether an authentication information record was created by the service providing apparatus by referring to an identifier included in the authentication information record when the request to extend the term of validity of the authentication information is received (§§ 0068, 0073, and 0092), and*

(3) *judge whether the extension request was made within the term of validity of the authentication information if the ticket was created by the service providing apparatus (§ 0096); and*

iii. *an authentication information updating section (license information management unit 48a) configured to extend the term of validity of the authentication information when the authentication information record was created by the service providing apparatus and the extension request was made within the term of validity of the authentication information (§ 0092).*

j. Ooho does not directly disclose the limitations:

iv. *authentication information created by the service providing apparatus;*  
*and*

v. *an identifier included in the authentication information.*

k. Aldis, however, teaches the limitations:



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vi. *authentication information created by a service providing apparatus (¶¶ 0058+, “license creation” by license clearinghouse); and*

vii. *an identifier included in the authentication information (¶¶ 0098+, “license ID”).*

1. Therefore, it would have been obvious to one of ordinary skill in the art, at the time the invention was made, to incorporate the ability to create authentication information that includes an identifier of Aldis’ clearinghouse into the device of Ooho that judges whether data was created by the device by referring to an identifier within the data since the claimed invention is merely a combination of old elements, and in the combination each element merely would have performed the same function as it did separately, and one of ordinary skill in the art would have recognized that the results of the combination were predictable.

21. Regarding claims 2-10, Ooho/Aldis discloses the limitations of claim 1, as described above. Ooho/Aldis, further, discloses the following limitations:

m. *Claim 2: The service providing apparatus as claimed in claim 1, wherein said authentication information managing section is configured to manage the authentication information, information related to a request source which makes the extension request to extend the term of validity of the authentication information, and an authority to extend the term of validity of the authentication information (Ooho, ¶¶ 0061, 0067, and 0068);*

n. *Claim 3: The service providing apparatus as claimed in claim 1, wherein said authentication information managing section is configured to manage, in a related*

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*manner, the authentication information, information related to a request source which made a creating request to create the authentication information, information related to a request source which makes the extension request to extend the term of validity of the authentication information, and an authority to extend the term of validity of the authentication information (Ooho, ¶¶ 0049, 0061, 0067, and 0068);*

o. Claim 4: *The service providing apparatus as claimed in claim 1, wherein said authentication information updating section is configured to judge whether a request source which made the extension request to extend the term of validity of the authentication information has an authority to extend the term of validity, and extends the term of validity of the authentication information when it is judged that the request source has the authority to extend the term of validity (Ooho, ¶¶ 0049, 0061, 0067, 0068, and 0092);*

p. Claim 5: *The service providing apparatus as claimed in claim 1, wherein said authentication information updating section is configured to extend the term of validity of the authentication information when it is judged that the request source has the authority to extend the term of validity, create new authentication information including the extended term of validity, and delete the old authentication information (Ooho, ¶¶ 0049, 0061, 0067, 0068, 0092, and 0133; and Aldis, fig. 11 with associated text);*

q. Claim 6: *The service providing apparatus as claimed in claim 1, wherein said authentication information managing section is configured to manage the authentication information and an extended term of validity of the authentication information in a related manner (Ooho, ¶ 0093);*

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r. Claim 7: *The service providing apparatus as claimed in claim 1, wherein said authentication information managing section is configured to manage the authentication information and a number of times the term of validity of the authentication information is extended in a related manner (Aldis, abstract; and ¶¶ 0016 and 0020);*

s. Claim 8: *The service providing apparatus as claimed in claim 5, further comprising: an extension response sending section configured to send an extension response including an identifier for identifying the newly created authentication information having the term of validity extended by said authentication information updating section (Ooho, ¶ 0041; and fig. 1 with associated text);*

t. Claim 9: *The service providing apparatus as claimed in claim 1, further comprising: a monitoring section configured to monitor the term of validity of the authentication information (Ooho, ¶ 0063);*

u. Claim 10: *The service providing apparatus as claimed in claim 1, further comprising: a notifying section configured to transmit information related to the term of validity of the authentication information to a request source which made a creating request to create the authentication information (Ooho, ¶ 0064).*

22. Regarding claims 11-21:

v. These claims are understood by the Examiner to be of substantially the same scope as claims 1-10. Accordingly, claims 11-21 are rejected in substantially the same manner as claims 1-10. If in response to this action the Applicant disagrees that the claims are of substantially the same scope, and provides evidence that they are of

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different scope, the Examiner may withdraw this rejection under 35 U.S.C. §103 and alternatively impose a restriction requirement.

23. The Examiner has pointed out particular references contained in the prior art of record within the body of this action for the convenience of the Applicant. Although the specified citations are representative of the teachings in the art and are applied to the specific limitations within the individual claim, other passages and figures may apply. Applicant, in preparing the response, should consider fully the entire reference as potentially teaching all or part of the claimed invention, as well as the context of the passage as taught by the prior art or disclosed by the Examiner.

#### ***Response to Arguments***

24. Applicants' arguments with respect to claims 1-21 have been considered but are moot in view of the new grounds of rejection.

#### ***Conclusion***

25. In accordance with *In re Lee*, 277 F.3d 1338, 1344-45, 61 USPQ2d 1430, 1434-35 (Fed. Cir. 2002), the Examiner finds that the references How Computers Work, Millennium Ed. By Ron White; How Networks Work, Bestseller Ed. By Frank J. Derfler et al.; How the Internet Works, Millennium Ed. By Preston Gralla; and Desktop Encyclopedia of the Internet by Nathan J. Muller, is additional evidence of what is basic knowledge or common sense to one of ordinary skill in this art. Each reference is cited in its entirety. Moreover, because these references are directed towards beginners (see *e.g.* "User Level Beginning..."), because of the references' basic

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content (which is self-evident upon examination of the references), and after further review of the entire record including the prior art now of record in conjunction with the factors as discussed in MPEP §2141.03 (where practical), the Examiner finds that these references are primarily directed towards those of low skill in this art. Because these references are directed towards those of low skill in this art, the Examiner finds that one of ordinary skill in this art must—at the very least—be aware of and understand the knowledge and information contained within these references.

26. Any inquiry of a general nature or relating to the status of this application or concerning this communication or earlier communications from the Examiner should be directed to Jacob C. Coppola whose telephone number is (571) 270-3922. The Examiner can normally be reached on Monday-Friday, 9:00 a.m. - 5:00 p.m. If attempts to reach the Examiner by telephone are unsuccessful, the Examiner's supervisor, Andrew Fischer can be reached at (571) 272-6779.

27. Information regarding the status of an application may be obtained from the Patent Application Information Retrieval (PAIR) system. Status information for published applications may be obtained from either Private PAIR or Public PAIR. Status information for unpublished applications is available through Private PAIR only. For more information about the PAIR system, see <http://pair-direct.uspto.gov>. Should you have questions on access to the Private PAIR system, please contact the Electronic Business Center (EBC) at (866) 217-9197 (toll-free).

/Jacob C. Coppola/  
Patent Examiner, Art Unit 3621  
December 15, 2008

/ANDREW J. FISCHER/  
Supervisory Patent Examiner, Art Unit 3621